

### Remarks

No claims are being amended, cancelled or added. In view of the following remarks, Applicants request reconsideration of the present application.

### Objections to Disclosure

The Examiner has requested that the Applicants renumber the pages and figures of the specification consecutively and to amend the specification to remove all references to Figs. 6 and 7.

However, Applicants have again enclosed herewith Figs. 6 and 7 for incorporation into the specification and request entry thereof. The MPEP clearly states that an applicant can incorporate a prior application by reference thereto *in the application transmittal letter*.

“...an applicant may incorporate by reference the prior application by including, in the continuation or divisional application-as-filed, a statement that such specifically enumerated prior application or applications are “hereby incorporated herein by reference.” *The statement may appear in the specification or in the application transmittal letter.*”

and

“For the incorporation by reference to be effective as a proper safeguard against the omission of a portion of a prior application, the incorporation by reference statement must be included in the specification-as-filed, *or transmittal letter-as-filed*, or in an amendment specifically referred to in an oath or declaration executing the application.” (MPEP 201.06(c), pp. 200-37, emphasis added)

The prior application (U.S. Patent Application Serial No. 09/141,405) of which the present application is a divisional application, was fully incorporated by reference into the present application in the application transmittal letter at page 2 (Box 5), as is permitted under MPEP 201.06(c). A copy of the application transmittal letter as-filed is attached to this response as Exhibit A. In the event that the Examiner maintains the refusal to enter Figs. 6 and 7, Applicants respectfully request a detailed reasoning as to why the foregoing incorporation by reference is improper.

In view of the foregoing, Figs. 6 and 7 are attached hereto as Exhibit B and are identical to Figs. 6 and 7 from the prior application. No new matter has been added. Therefore, Applicants request entry of these figures and removal of the Examiner's objection to the specification.

### **Claim Rejections – Sanjurjo et al.**

The Examiner has rejected Claims 80, 82-84, 88, 91-93, 95, 97, 101, 103, 104, 106, 109, 111 and 112 under 35 USC 102(e) as being anticipated by Sanjurjo et al. Further, the Examiner has rejected Claims 81, 98, 100, 105, 107, 108, 124-136 (sic. should be 124-126) and 133, 135 and 136 under 35 USC 103(a) as being obvious in view of Sajurjo et al. (Applicants note that Claim 107 has previously been cancelled and believe that the rejection of Claims 124-136 was intended to be a rejection of Claims 124-126). Applicants traverse this rejection.

Applicants had submitted the provisional application (Serial No. 60/038,262) in support of the assertion that the effective filing date of the claims of the present application is February 24, 1997 and therefore Sanjurjo et al. is not prior art to the present application. The Examiner has maintained the rejection with respect to some of the claimed embodiments, stating that only certain claimed embodiments have an effective filing date of February 24, 1997.

To be afforded the priority date, the specification of the provisional must contain a written description of the invention and the manner and process of making and using it, in such full, clear, concise, and exact terms to enable an ordinarily skilled artisan to practice the invention claimed in the non-provisional application. New Railhead Manufacturing, L.L.C. v. Vermeer Manufacturing Company, 298 F.3d 1290 (Fed. Cir. 2002). It has been held however that the disclosure as originally filed does not have to provide *in haec verba* support for the claimed subject matter at issue. Crown Operations Int'l, Ltd. v. Solutia Inc., 289 F.3d 1367, 1376, 62 USPQ2d 1917, 1922 (Fed. Cir. 2002). Further, the written description requirement for a claimed genus may be satisfied through sufficient description of a representative number of species. MPEP 2163.05. There may be situations where

one species adequately supports a genus. In re Rasmussen, 650 F.2d 1212, 1214, 211 USPQ 323, 326-27 (CCPA 1981).

It is respectfully submitted that the parent provisional application provides sufficient support for each of the claims pending in the present application such that the claims have an effective filing date preceding the filing date of Sanjurjo et al.

Page 40 of the provisional application illustrates certain *preferred* embodiments of phosphor host material and dopants for selected applications. However, the disclosure is not limited thereto. The provisional application illustrates numerous combinations of host materials and dopants that are useful as phosphors at pages 28-29 and pages 39-41. These include yttrium oxysulfides such as  $Y_2O_2S$ , sulfides such as  $ZnS$ , silicates such as  $Zn_2SiO_4$  and  $Y_2SiO_5$  and thiogallates such as  $SrGa_2S_4$ , all with various dopants. It is respectfully submitted that the ordinarily skilled artisan would recognize which of these compounds can be used for different applications such as cathodoluminescent applications. It is therefore respectfully submitted that the provisional application provides a sufficient written description under 35 USC §112 ¶ 1 such that an ordinarily skilled artisan would be able to practice the invention recited in the claims.

In view of the foregoing, Applicants request withdrawal of this rejection with respect to Claims 80-84, 88, 91-93, 95, 97, 98, 100, 101, 103-106, 108, 109, 111, 112, 124-126, 133, 135 and 136.

### **Double Patenting Rejections**

The Examiner has rejected numerous claims under the judicially created doctrine of obviousness-type double patenting over Applicants co-pending applications and issued patents. Specifically, the Examiner has provisionally rejected Claims 80-83, 92, 97-98, 103, 113 120, 122 and 123 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 137-141 of co-pending Patent Application Publication No. 2001/0042853. Applicants note that this publication issued on April 29, 2003 as U.S. Patent No. 6,555,022 and that Claims 137-141 were not patented. Therefore, removal of this provisional rejection is requested.


The Examiner has also rejected numerous claims of the present application under the judicially created doctrine of obviousness-type double patenting over commonly-owned

U.S. Patent Nos. 6,153,123 and 6,168,731. Upon the indication of otherwise allowable subject matter, Applicants will submit the appropriate Terminal Disclaimer with respect to these patents, as appropriate.

This response is being filed with a Request for Continued Examination (RCE), which includes the fee for a three-month extension of time. It is not believed that any additional fees are owed with respect to this response, however, any such additional fees can be charged to Deposit Account 50-1419.

Respectfully submitted,

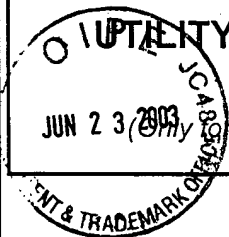
MARSH FISCHMANN & BREYFOGLE LLP

By: 

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Aurora, Colorado 80014  
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Date: June 18, 2003

## **Exhibit A**



# UTILITY PATENT APPLICATION TRANSMITTAL (Large Entity)

JUN 23 2003 Only for new nonprovisional applications under 37 CFR 1.53(b))

Docket No.  
41890-01280

Total Pages in this Submission  
155

## TO THE ASSISTANT COMMISSIONER FOR PATENTS

Box Patent Application  
Washington, D.C. 20231

Transmitted herewith for filing under 35 U.S.C. 111(a) and 37 C.F.R. 1.53(b) is a new utility patent application for an invention entitled:

"CATHODOLUMINESCENT PHOSPHOR POWDERS, METHODS FOR MAKING PHOSPHOR POWDERS AND DEVICES INCORPORATING SAME"

and invented by:

Mark J. Hampden-Smith of 2901 Maximillian NW, Albuquerque, NM 87104; Toivo T. Kodas of 11102 San Rafeal Drive NE, Albuquerque, NM 87122; James Caruso of 7721 Cedar Canyon Court NE, Albuquerque, NM 87122; Daniel J. Skamser of 10327 Hackamore Place SW, Albuquerque, NM 87121; Quint H. Powell of 14336 Grand Avenue NE, Albuquerque, NM 87123 and Klaus Kunze of 800 Oro Real Drive NE, Albuquerque, NM 87123

If a **CONTINUATION APPLICATION**, check appropriate box and supply the requisite information:

☐ Continuation ☒ Divisional ☐ Continuation-in-part (CIP) of prior application No.: 09/141,435

Which is a:

☐ Continuation ☐ Divisional ☐ Continuation-in-part (CIP) of prior application No.: \_\_\_\_\_

Which is a:

☐ Continuation ☐ Divisional ☐ Continuation-in-part (CIP) of prior application No.: \_\_\_\_\_

Enclosed are:

### Application Elements

1. ☐ Filing fee as calculated and transmitted as described below
2. ☒ Specification having 108 pages and including the following:
  - a. ☒ Descriptive Title of the Invention
  - b. ☐ Cross References to Related Applications (if applicable)
  - c. ☐ Statement Regarding Federally-sponsored Research/Development (if applicable)
  - d. ☐ Reference to Microfiche Appendix (if applicable)
  - e. ☒ Background of the Invention
  - f. ☒ Brief Summary of the Invention
  - g. ☒ Brief Description of the Drawings (if drawings filed)
  - h. ☒ Detailed Description
  - i. ☒ Claim(s) as Classified Below
  - j. ☒ Abstract of the Disclosure

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# UTILITY PATENT APPLICATION TRANSMITTAL (Large Entity)

(Only for new nonprovisional applications under 37 CFR 1.53(b))

Docket No.  
41890-01280

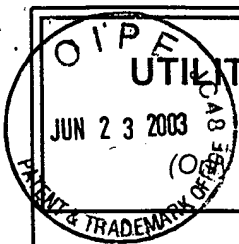
Total Pages in this Submission  
155

## Application Elements (Continued)

3. ☒ Drawing(s) (when necessary as prescribed by 35 USC 113)
- a. ☐ Formal                      Number of Sheets \_\_\_\_\_
- b. ☒ Informal                      Number of Sheets 35
4. ☒ Oath or Declaration
- a. ☐ Newly executed (original or copy)      ☐ Unexecuted
- b. ☒ Copy from a prior application (37 CFR 1.63(d)) (for continuation/divisional application only)
- c. ☐ With Power of Attorney      ☐ Without Power of Attorney
- d. ☐ DELETION OF INVENTOR(S)  
Signed statement attached deleting inventor(s) named in the prior application,  
see 37 C.F.R. 1.63(d)(2) and 1.33(b).
5. ☒ Incorporation By Reference (usable if Box 4b is checked)  
The entire disclosure of the prior application, from which a copy of the oath or declaration is supplied  
under Box 4b, is considered as being part of the disclosure of the accompanying application and is hereby  
incorporated by reference therein.
6. ☐ Computer Program in Microfiche (Appendix)
7. ☐ Nucleotide and/or Amino Acid Sequence Submission (if applicable, all must be included)
- a. ☐ Paper Copy
- b. ☐ Computer Readable Copy (identical to computer copy)
- c. ☐ Statement Verifying Identical Paper and Computer Readable Copy

## Accompanying Application Parts

8. ☐ Assignment Papers (cover sheet & document(s))
9. ☐ 37 CFR 3.73(B) Statement (when there is an assignee)
10. ☐ English Translation Document (if applicable)
11. ☐ Information Disclosure Statement/PTO-1449      ☐ Copies of IDS Citations
12. ☒ Preliminary Amendment
13. ☒ Acknowledgment postcard
14. ☒ Certificate of Mailing
- ☐ First Class      ☒ Express Mail (Specify Label No.): EL702181980US



UTILITY PATENT APPLICATION TRANSMITTAL  
(Large Entity)

(Office use only for new nonprovisional applications under 37 CFR 1.53(b))

Docket No.  
41890-01280

Total Pages in this Submission  
155

Accompanying Application Parts (Continued)

15. ☐ Certified Copy of Priority Document(s) (if foreign priority is claimed)

16. ☐ Additional Enclosures (please identify below):

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JUN 25 2003  
TC 1700

Fee Calculation and Transmittal

CLAIMS AS FILED

For	#Filed	#Allowed	#Extra	Rate	Fee
Total Claims		- 20 =	0	x \$18.00	\$0.00
Indep. Claims		- 3 =	0	x \$80.00	\$0.00
Multiple Dependent Claims (check if applicable) <input type="checkbox"/>					\$0.00
BASIC FEE					
OTHER FEE (specify purpose) _____					\$0.00
TOTAL FILING FEE					\$0.00

- ☐ A check in the amount of \_\_\_\_\_ to cover the filing fee is enclosed.
- ☐ The Commissioner is hereby authorized to charge and credit Deposit Account No. \_\_\_\_\_ as described below. A duplicate copy of this sheet is enclosed.
- ☐ Charge the amount of \_\_\_\_\_ as filing fee.
  - ☐ Credit any overpayment.
  - ☐ Charge any additional filing fees required under 37 C.F.R. 1.16 and 1.17.
  - ☐ Charge the issue fee set in 37 C.F.R. 1.18 at the mailing of the Notice of Allowance, pursuant to 37 C.F.R. 1.311(b).

  
Signature

Dated: December 29, 2000

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cc:



## **Exhibit B**